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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,432	08/21/2003	Dan William Elsasser	P1929US00	8469
24333	7590	06/07/2004	EXAMINER	
<b>GATEWAY, INC.</b> ATTN: SCOTT CHARLES RICHARDSON 610 GATEWAY DRIVE MAIL DROP Y-04 N. SIOUX CITY, SD 57049				REIS, TRAVIS M
		ART UNIT		PAPER NUMBER
		2859		
DATE MAILED: 06/07/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/645,432	ELSASSER ET AL.
<b>Examiner</b>	<b>Art Unit</b>	
	Travis M Reis	2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on \_\_\_\_.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-16 and 18-23 is/are pending in the application.  
4a) Of the above claim(s) 17 and 24-32 is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-16 and 18-23 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 21 August 2003 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20030821.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_ .

**DETAILED ACTION**

***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I, as illustrated in Figures 1-6.

Species II, as illustrated in Figure 7.

Species III, as illustrated in Figure 8.

Species IV, as illustrated in Figure 9.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either

instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mr. Proehl on May 20, 2004 a provisional election was made without traverse to prosecute the invention of Species I, claims 1-16 & 18-23. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 17 & 24-32 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.-

5. Claims 1, 3-5, 8-11, 14-16, 18, & 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Rubey (U.S. Patent 4068613).

With reference to claims 1, 3-5, 8, 10, 11, 14-16, 18, 20, 22, & 23, Rubey discloses, in the embodiment shown in Figures 13-15, a circular shock force indicating device (13) comprising a base member (23) having a substantially flat top surface, and an adhesive backing (49) on a bottom surface (col. 3, lines 64-67; col. 13, lines 29-30); a top member (93)

having a raised portion and a substantially flat top portion disposed in spaced relation above said base member forming a cavity between said top member and said base member (Figure 13); a bearing (99) disposed substantially centered within said cavity connected to a spring (91), the other end of the spring connected to the base (Figure 13); and a pressure sensitive paper material (101) disposed on said base member comprising concentric circle indicating scale marks (21); wherein movement of said bearing over said pressure sensitive material produces a visually identifiable path (107) on said pressure sensitive material tracing movement of said bearing when said bearing moves in response to a shock force on said device (Figures 13-15).

With reference to claims 9 & 21, in a broad sense, the material of the spring and the material of the bearing are considered to form a single piece of elastic material. Furthermore, claims 9 & 21 are “product by process” claims since the claim language is directed to the steps required to form a single piece of elastic material. Therefore, these steps have been given no patentable weight since it has been held that 1) the determination of patentability in “product by process” claims is based on the product itself, even though such claims are limited and defined by the process, and 2) the product in a “product by process” claim is unpatentable if it is the same as, or obvious from a product of the prior art, even if the prior art product was made by a different process. In re Thorpe et al., 227 USPQ 964 (Fed. Cir. 1985).

6. Claims 1-5, 13, 16, 18, & 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Itoh (U.S. Patent 3707722).

Itoh discloses a circular shock force indicating device comprising a base member (4) having a flat top surface, and an adhesive surface on a bottom surface (col.3, line 44); a transparent top member (5) having a raised portion and a substantially flat top portion disposed in spaced relation above said base member forming a cavity between said top

member and said base member (Figure 1); a bearing (9) disposed substantially centered within said cavity; and a pressure sensitive material (3) disposed on said base member; wherein movement of bearing over said pressure sensitive material produces a visually identifiable path on said pressure sensitive material tracing movement of said bearing when said bearing moves in response to a shock force on said device, wherein said base member and said top member provide a compressive force to said bearing such that said bearing is held in place until said device is subjected to a shock force greater than a predetermined threshold (Figure 2).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rubey.

Rubey discloses all of the instant claimed invention as stated above in the rejection of claims 1, 3-5, 8, 10, 11, 14-16, 18, 20, 22, & 23, but does not disclose in the embodiment of Figures 13-15 that said top member is dome-shaped.

Rubey discloses, in the embodiment shown in Figures 11 & 12, a shock force device (13) with a dome-shaped top member (79) (Figures 11 & 12). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to replace the flat top member disclosed by Rubey with the dome-shaped top member disclosed by Rubey in order to save material.

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rubey in view of Mangini et al. (U.S. Patent 5046609).

Rubey discloses all of the instant claimed invention as stated above in the rejection of claims 1, 3-5, 8, 10, 11, 14-16, 18, 20, 22, & 23, but does not disclose said pressure sensitive paper is carbon paper.

Mangini et al. discloses a kit for distributing pharmaceutical products which uses carbon paper to minimize the work involved in record keeping (col. 2 lines 42-47). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to replace the paper disclosed by Rubey with the carbon paper disclosed by Mangini et al. in order to minimize the work involved in record keeping.

***Allowable Subject Matter***

10. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not disclose or clearly suggest the bearing is disposed within an indentation, in combination with the remaining limitations in the claims.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Smith discloses a collision switch (U.S. Patent 2475728). Kerrigan discloses an impact indicator for containers (U.S. Patent 2601440). Harrison discloses a shock registering device (U.S. Patent 2825297). Rips discloses shock gauge (U.S. Patent 3021813). Meeder discloses a mechanical damage indicator (U.S. Patent 3369521). Williams discloses a shock indicating device (U.S. Patent 3373716). Smith discloses a shock indicator for shipping container (U.S. Patent 3515091). Boardman discloses an apparatus and methods for recording acceleration (U.S. Patent 3782204). Greenhug discloses impact monitor or shock

indicator (U.S. Patent 3909568).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis M Reis whose telephone number is (571) 272-2249. The examiner can normally be reached on 8-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for all communications.

Travis M Reis  
Examiner  
Art Unit 2859

tmr  
May 27, 2004



Diego Gutierrez  
Supervisory Patent Examiner  
Technology Center 2800

CHRISTOPHER W. FULTON  
PRIMARY EXAMINER